

Application No. 09/991,025
Amendment "A" dated April 24, 2006
Reply to Office Action mailed January 24, 2006

REMARKS

The Office Action, mailed January 24, 2006, considered claims 1-43. Claims 22, 23, 25, 28, 29 and 33-36 were objected to because of informalities. Claims 1, 3-6, 8-13, 18-33, 35-38, and 41 were rejected under 35 U.S.C. § 102(e) as being anticipated by Carruthers et al. (U.S. Patent Application Publication No. 2002/0128904). Claims 2, 7, 14-17, 34, 39-40 and 42-43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Carruthers, et al., in view of Cannon (U.S. Patent No. 6,286,005).¹

By this paper, Claims 1, 13, 22-26 and 32-36 have been amended, while claims 27-31 have been cancelled and new claim 44 has been added, such that claims 1-26 and 32-44 remain pending of which claims 1, 13 and 21 are the only independent claims at issue. Applicant respectfully submits that the claim amendments and new claims are supported by the disclosure in the specification and includes at least the disclosure in the referenced citations below. Support for new claim 44 is also clearly supported by the disclosure in ¶¶ 21, 38-39.

Claims 22, 23, 25, 28, 29 and 33-36 were objected to because of informalities. Those informalities have been corrected, and some of the claims (28-29) have been cancelled, such that all of those objections are now moot and should be withdrawn. Additionally, it should be noted that other minor changes have been made to fix additional minor informalities, such as to reflect correct dependencies, as reflected in the amended claims above.

It should first be noted that while Carruthers is directed toward "online users" and "online advertising ... directed to Web users," (See Carruthers "abstract", ¶ 4, and Claim 1), the present invention is directed toward viewers of programming who are, possibly, only intermittently connected to a network. (See specification ¶ 14.) As such, Carruthers requires that users have a persistent two way connection with the advertising controller — i.e., connections exemplified by ISPs and POPs in order for . (See Carruthers ¶¶ 19, 22, 32.) The present invention, in contrast, allows a receiver module that is only intermittently connected to a network to selectively display

¹ Although the prior art status and some of the assertions made with regard to the cited art is not being challenged at this time, inasmuch as it is not necessary following the amendments and remarks made herein, which distinguish the claims from the art of record, Applicants reserve the right to challenge the prior art status and assertions made with regard to the cited art, as well as any official notice, which was taken in the last office action, at any appropriate time in the future, should the need arise, such as, for example in a subsequent amendment or during prosecution of a related application. Accordingly, Applicants' decision not to respond to any particular assertions or rejections in this paper should not be construed as Applicant acquiescing to said assertions or rejections.

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appropriate advertising, based upon target advertising criteria, to a user even when the receiver module is not connected to a central control module. (See Specification ¶¶ 2, 13, 19, 21.)

It should be further noted that, in Carruthers, it is the central server which determines which advertising content is displayed to the user during a connection. (See Carruthers ¶ 19-22.) In the present invention, however, it should be appreciated that it is the receiver module that selects which advertising content is displayed to the user, even when the receiver is disconnected from the central server at the time the advertising content is selected and displayed to the user. (See Specification ¶ 17, 19-22). Accordingly, Carruthers, is clearly distinguished from the present invention for at least failing to teach or suggest any embodiment whereby advertising content is selected and displayed by a receiver computing system even when the receiver computing system is disconnected from the server computing system, as recited in the claims in combination with the other recited claim elements.

According to the present invention, the receiver module can collect and store historic advertising data to be uploaded later and for later use by the control and planning modules. (See Specification ¶ 22.) Many of the pending claims also clarify this. Carruthers, in contrast, merely collects historic data within the central control module(s) during the time a network connection is persistent.

The first independent claim, claim 1, was rejected under 35 U.S.C. § 102(e) as being anticipated by Carruthers, et al. As described above, however, claim 1 is clearly not anticipated by Carruthers. In particular, Claim 1 enables advertising to be selectively displayed and historic data to be collected even during times absent a network connection, as recited in combination with the other recited claim elements, which is something that Carruthers never teaches or suggests for at least the reasons mentioned above. Accordingly, the Applicant now respectfully requests the rejection to Claim 1, based upon Carruthers, be withdrawn and Claim 1 allowed.

Claims 2-12, dependent upon Claim 1, were rejected under 35 U.S.C. § 102(e) as being anticipated by Carruthers, et al., or under 35 U.S.C. § 103(a) as being unpatentable over Carruthers, et al., in view of Cannon (U.S. Patent No. 6,286,005). As the objections to the independent Claim 1 should now have been overcome, the objections to the dependent claims -- whether under 35 U.S.C. § 102(e) or under 35 U.S.C. § 103(a), should now also have been overcome.

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The next independent claim, claim 13, is a computer program product claim corresponding directly to the method of claim 1 and expressly incorporates the limitations of claim 1. Accordingly, the remarks made with regard to claim 1 are equally applicable to claim 13. As such, the rejection of Claim 13 should also be found overcome and allowable over the art of record.

Claims 14-20, dependent upon Claim 13, were rejected under 35 U.S.C. § 102(e) as being anticipated by Carruthers, et al., or under 35 U.S.C. § 103(a) as being unpatentable over Carruthers, et al., in view of Cannon (U.S. Patent No. 6,286,005). As the objections to the independent Claim 13 should now have been overcome, the objections to the dependent claims – whether under 35 U.S.C. § 102(e) or under 35 U.S.C. § 103(a), should now also have been overcome.

The last independent claim is claim 21. It will be noted that claim 21 has not been amended by this paper because a *prima facie* case of anticipation has not been established for rejecting the claim. In particular, claim 21 requires “a step for defining a weight for the advertisement based upon the advertising impression goal and the available advertising inventory,” and as further recited, “the weight defin[es] the display frequency of the advertisement to achieve the advertising impression goal.” While the Examiner cites to Carruthers for teaching the use of “weight” in an advertising campaign, it should be noted that Carruthers never defines weights. The only reference to weight in Carruthers is

The order [in which advertisements are to be displayed] is based preferably both upon priority and *some weighting mechanism* that indicates how many impressions are needed by each campaign.

(See Carruthers ¶ 34 (emphasis added). In view of this extremely limited disclosure regarding “weights”, Carruthers is a completely inadequate reference for anticipating the recited claim. In particular, Carruthers fails to disclose or suggest how weights are defined, computed, or assigned in anyway. At the very least, Carruthers clearly fails to disclose or suggest any embodiment, as claimed, wherein the weight is based upon the advertising impression goal and the available advertising inventory and wherein the weight defines the display frequency of the advertisement to achieve the advertising impression goal, as recited in combination with the recited claim elements.

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Carruthers also fails to disclose or suggest embodiments, as recited in the other claims, wherein the weights are further defined as relative or absolute weights in regard to the flexible and committed advertisements that they are used with. (See claims 23-26 and new claim 44).

Accordingly, although Carruthers does disclose that a weighting scheme of some sort could be used in selecting advertisements, Carruthers clearly fails to teach "a method for weighting scheduled advertisements," which is what is recited and required by claim 21. In fact, claim 21 is directed specifically to a unique and novel way for "weighting scheduled advertisements". This unique and novel way for weighting scheduled advertisements includes:

a step for identifying an advertising impression goal for the display of an advertisement to at least one target viewer; and

a step for defining a weight for the advertisement based upon the advertising impression goal and the available advertising inventory, the weight defining the display frequency of the advertisement to achieve the advertising impression goal.

If the Examiner maintains the rejection of claims 21 and the corresponding dependent claims, in this regard, the Applicant respectfully requests that the Examiner clarify particularly how the mention of "some weighting mechanism" and its use in a priority ordering mechanism as in Carruthers discloses "a method for weighting scheduled advertisements", as disclosed and claimed in the current invention.

Claims 22-26 are dependent upon Claim 21 and were either objected to for formalities or rejected under 35 U.S.C. § 102(e) as being anticipated by Carruthers, et al. As the rejection of independent Claim 21 should now be overcome, these dependent claims should also now be in condition for allowance.

Claim 32 was rejected under 35 U.S.C. § 102(e) as being anticipated by Carruthers, et al. The Examiner's rejection of Claim 32 was included in and followed the same reasoning as the rejection of Claims 21 and 27. Nevertheless, claim 32 has been amended to depend on claim 21. Accordingly, the discussion of claim 21 clearly applies to claim 32. Accordingly, the Applicant respectfully requests that the Examiner withdraw the rejection of Claim 32 and the remaining dependent claims (33-43) that depend on claims 32 and 21.

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For at least the foregoing reasons, Applicant respectfully submits that all of pending claims are now in condition for allowance. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 24 day of April, 2006.

Respectfully submitted,



RICK D. NYDEGGER
Registration No. 28,651
JENS C. JENKINS
Registration No. 44,803
Attorneys for Applicant
Customer No. 047973

RDN:JCJ:tmb:ppa
PPA0000003190V001